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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,037	11/19/2003	David Charles Lyons	12929.1102USU1	7142
23552	7590	01/26/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PRICE, CARL D	
			ART UNIT	PAPER NUMBER
			3749	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,037

Applicant(s)

LYONS ET AL.

Examiner

CARL D. PRICE

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 9, 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/01/04; 03/31/04</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### Specification

The disclosure is objected to because of the following informalities: Applicant should update the information related to the co-pending patent application discussed on page 16, lines 18-21.

Appropriate correction is required.

### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 18, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the recitation “**depending on a state of the fireplace**” causes the claim to be vague and indefinite since it is unclear what structure, arrangement, condition, etc. would necessarily determine “**a state**” of the fireplace.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 3749

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-25: Rejected under 35 U.S.C. 102 and 103**

With regard to the following rejections of claims under 35 U.S.C. 102(b) and 103 the recitations “fireplace” (claims 1-14 and 20-23) and “for a gas fireplace” (claims 20-23) have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With regard to the following rejections of claims under 35 U.S.C. 102(b) and 103 the recitations “a combustion chamber” (claims 1 and 20) and “manually controlled” (claim 14) are deemed to be recitations of the intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process

Art Unit: 3749

of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

**Rejections under 35 U.S.C. 102(b)**

Claims 1-4, 6, 8, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by **US002445250 (Steingruber)**.

**US002445250 (Steingruber)** shows and discloses an apparatus comprising:

- an enclosure defining a chamber (3); and
- a backlighting system positioned at a back portion of the enclosure and including at least one light source (64) to shine light upon any components within and of the chamber, such as on the “lattice” structures formed by the louvers (37) and “lattice” surfaces defined by corrugated wall surfaces (38; see column 4, lines 60-65):
- wherein the enclosure includes:
  - o a lower panel (i.e. – the lower most and lower rear of panel ) defining an opening (41 at 52; or, 59 at 62) in the back portion of the combustion chamber, and
  - o wherein the socket mounted bulb light source is positioned at least partially below the lower panel so that the light from the light source shines through the opening into the combustion chamber (see column 5, line 70- column 6, line 2, and column 8, lines 13-31: “The lamp 64 is positioned below the louvers 37 so that the light rays from the lamp will be directed against the lower surfaces of the louvers and reflected forwardly through the reflector shell 33, thereby creating the illusion of an open flame when the heater is viewed from the front”); and
  - o wherein the backlighting system is automatically controlled by the “fireplace” depending on a state of the fireplace. That is, automatically when the manually controlled switch simultaneously turns on with the lamp and

Art Unit: 3749

heater. When a natural fire is being simulated within the fireplace (applicant's claim 11).

**Claims Rejected under 35 U.S.C. 102(b)**

Claims 1-4, 8, 10, 11, 14, 15-17, 19-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by **GB 2261942 (Morley et al)**.

**GB 2261942 (Morley et al)** shows and discloses an apparatus comprising:

- an enclosure (6) defining a combustion chamber (at 12, 20, 22, 30, etc.) and an open front (at 5), the enclosure including at least a lower panel (e.g. – 9, 10) and a back panel (6, 29, 30) having a surface lattice structure defined by a mottled or patterned surface forming recesses and projections according to the following found on page 6, last paragraph – page 7, line 4 and page 9:

The reflectors 29 and 30 are constructed from stainless steel sheet material having a mottled or patterned surface produced by deformation of the sheet to form series of raised portions and depressions extending over the whole surface of the sheet. The deformations are preferably of generally diamond shape and of uniform size having a major dimension of around

While in the illustrated embodiment the reflector members 29 and 30 are of mottled or patterned form, they may be of plain construction if desired. The reflectors may also be formed from reflective sheet material other than stainless steel and the surface deformations may be of circular, random or other shape and of various sizes dependent on the visual effect required. Moreover while the light units are preferred to enhance the overall effect, either or both may be omitted if desired. The mottled or patterned reflector means may also be employed in fires of different construction and incorporating different forms of live fuel effect assembly.

- a burner (8) positioned adjacent to the lower panel;
- a simulated log set (20) positioned adjacent to the burner; and
- a backlighting system (25) positioned between the log set and the back panel of the enclosure, the system including a light source (25) to shine light upon components of the fireplace including at least the back panel;
- wherein the enclosure includes a lower panel defining an opening (27 adjacent 17) in a back lower panel portion of the combustion chamber, and
- wherein the light source is positioned at least partially below the lower panel so that the light from the light source shines through the opening into the combustion chamber. Note the discussion at on page 6, last paragraph – page 7, line 4 and page 9 partially reproduced herein above. And, in regard to claims 8, 11, 18, 23 and 24, when a natural fire is being simulated within the fireplace the light bulb is turned on.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **GB 2261942 (Morley et al)** or **US002445250 (Steingruber)**.

**GB 2261942 (Morley et al)** or **US002445250 (Steingruber)** show and disclose the invention substantially as set forth in the claims with possible exception to the type and number of light bulbs, the type of socket material, and the dependence or inter-dependence of operating the illumination lamp system and burner fire system relative to each other.

In regard to claim 6, noting that the bulb of **GB 2261942 (Morley et al)** or **US002445250 (Steingruber)** is capable of operating within operating temperature ranges of the heater, to select the properties of the light source to withstand high temperature generated by the simulated fire fireplace is deemed an obvious design expedient since the light source would necessarily be capable of withstanding high temperatures generated by the fireplace in order to operate as intended. Also, in regard to claim 6, 7, Official Notice is taken that a halogen bulb having a ceramic sockets (see CA2385446 (Bereg) cited) are well known in the illumination field of endeavor. Additionally, in regard to claims 5 and 6, since the type and number of light sources and socket material used would depend on numerous design concerns such as the desired amount and distribution of light, the relative intensity of the light, the size and shape of the chamber, the location of the light source with regard to the chamber openings, etc., to use plural bulbs and to select a halogen bulb having a ceramic sockets can be viewed as nothing more than a mere matter of choice in design absent the showing of any new or unexpected results produced therefrom over the prior art of record.



Art Unit: 3749

In regard to claims 10, to operate the light bulb and/or the burner produced fire independently each for their separate purpose , would have been obvious to a person having ordinary skill in the art since the operation of the lamp bulb for illumination and operation of the burner to produce heat are necessarily dependant on the each other.

**Allowable Subject Matter**

Claims 9, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

See the attached USPTO FORM 892 for prior art made of record and not relied upon but which is considered pertinent to applicant's disclosure.

**USPTO CUSTOMER CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is (571) 272-4880. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571) 272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3749

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Carl D. Rice', with a stylized, flowing script.

CARL D. RICE

Primary Examiner

Art Unit 3749

CP